

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
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Ziegerson)	Art Unit: 1619
)	
Application No. 10/553,003)	Examiner: Greene, Ivan A
)	
Filing Date: August 15, 2006)	Confirmation No. 1281
)	
For: METHOD FOR THE PRODUCTION OF)	
EMULSION-BASED MICRO PARTICLES)	

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment	BALLARD SPAHR LLP
Commissioner for Patents	
P.O. Box 1450	
Alexandria, VA 22313-1450	Customer Number 23859

Sir:

In response to the Restriction Requirement mailed July 1, 2009, please consider the remarks and elections below. In that Restriction Requirement, the Examiner set a one-month period in which to reply, *i.e.*, by August 1, 2009. Accordingly, enclosed herewith is a Request for a Three-Month Extension of time. Thus, this paper is timely.

In the current Restriction Requirement, the Examiner restricted the application and required an election of one of the following four Groups under 35 U.S.C. § 121 and 372:

- Group I: Claims 1-15, drawn to a method of making;
- Group II: Claims 16-31, drawn to a method of making;
- Group III: Claims 32-25, drawn to a method of making; and
- Group IV: Claims 36-41, drawn to an apparatus.

As required in response to this Restriction Requirement, Applicant elects Group I, which Claims 1-15 reads thereon. This election is made with traverse.

The Examiner alleged that the inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features. In particular, the Examiner cited Kuhrts (US 6953593), and stated that this reference discloses a way of producing sustained released powders

by mixing oil in a mixer and then atomizing the oil to be sparyed onto a powder (see pages 2 and 3 of the Restriction Requirement).

Applicants are confused by this Restriction. A common technical feature recited in all of the claims is the use of “a packed bed apparatus under laminar flow conditions” (*see* step c of independent claim 1 (*i.e.*, Group I), step e of independent claim 16 (*i.e.*, Group II), and step a of independent claim 32 (*i.e.*, Group III)). In making the Restriction Requirement the Examiner only referred to claim 32 as having the special technical feature of preparing an emulsion in a packed bed apparatus under laminar flow conditions. As noted, Groups I and II also share this feature. Moreover, the Examiner’s citation of Kuhrts is puzzling since this reference does not disclose the use of a packed bed apparatus to make microcapsules, much less a packed bed apparatus under laminar flow conditions. The process of Kuhrts seems entirely unrelated to the special technical feature shared in Groups I-III. Because the Examiner has not shown that the claims are not so linked to form a general inventive concept under PCT Rule 13.1, withdrawal or reconsideration of this restriction requirement is respectfully requested. At the very least Applicants request that Groups I-III be examined together in one application.

Moreover, the present application is a national stage application filed under 35 U.S.C. § 371, and is governed by the unity of invention practice set forth in PCT Rule 13 and 37 C.F.R. § 1.499. In this regard, the Examiner’s attention is respectfully directed to § 1893.03(d) of the MPEP. As evidenced by the International Search Report (form PCT/ISA/210), as well as the International Preliminary Report on Patentability (form PCT/IB/373), the International Examiner searched and examined all of the claims (1-41) during the international phase of this application (indeed, the International Examiner found all of the claims met the novelty and inventive step requirements). Thus, the examination of all of the claims (1-41) in the present national stage cannot reasonably be construed to impose an undue burden on the Examiner.

In summary, Applicants assert that the requirement of unity of invention as defined under PCT Rules 13.1 and 13.2 have been met in that the claims of Groups I-III share the same special technical feature. Further, the Examiner would not be seriously burdened by searching and examining all the claims in a single application.

CONCLUSION

Enclosed herewith is payment in the amount of \$1,100.00 for the fee under 37.C.F.R. §1.17(a)(3) for the Three-Month Extension of Time. No additional fees are believed due; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,
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CERTIFICATE OF EFS-WEB TRANSMISSION UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence – including any items indicated as attached, enclosed, or included – is being transmitted by EFS-WEB on the date indicated below.

/Christopher L. Curfman/

October 5, 2009

Christopher L. Curfman

Date